

REMARKS

Claims 134-175 are pending in this Application, with claims 134, 145, 149, 157, 166, and 175 being independent claims. Claims 93 and 98 were rejected under 35 U.S.C. § 112, second paragraph. Claims 88, 90-92, 94-96, 103-105, 109-115, 118-124, 130, and 132-133 were rejected under 35 U.S.C. § 103(a) as being obvious over Kelley et al. "Magic Mouse: Tactile and Kinesthetic Feedback in the Human-computer Interface Using an Electromagnetically Actuated Input/Output Device" (hereafter "the *Kelley* article"). These rejections are moot in view of the cancellation of claims 88-133.

Interview

Applicants appreciate the courtesies extended by the Examiner during the telephone interview conducted on July 11, 2003. During the interview, independent claims 134, 145, 149, 157, 166, and 175 were discussed. The Examiner agreed that the allowable subject matter indicated in the Office Action had been incorporated into independent claims 145, 166, and 175. Independent claims 134, 149, and 157 were discussed with respect to the *Kelley* article. Applicants' Representatives discussed that the *Kelley* article did not disclose, inherently or otherwise, a duration parameter as recited in independent claims 149 and 157. Additionally, Applicants' representatives discussed that the particular devices disclosed in the *Kelley* article did not output a first force feedback and second force feedback, as recited in independent claim 134.

Claims 145, 166, and 175 are Patentable

As discussed in the interview, claims 145, 166, and 175 incorporate the allowable subject matter of previously allowed and objected to claims. Accordingly, independent claims 145, 166, and 175 are patentable over the cited references.

Claims 146-148 and 167-174 depend from independent claims 145 and 166, respectively, and are allowable for at least this reason. Applicants respectfully request allowance of these claims.

Claim 134 is Patentable Over Kelley

As discussed during the interview, the *Kelley* article fails to disclose or suggest “generating a first force feedback [and]... generating a second force feedback, the second force feedback being of a different type of force feedback than the first force feedback,” as recited in independent claim 134.

The *Kelley* article discloses a force sensation that may be felt when moving to the right, and a force sensation when moving to the left. However, the force sensation when moving to the right and the force sensation when moving to the left are the same *type* of sensation. Claim 134 recites that the first force sensation and the second force sensation are of different types. At least because the *Kelley* article does not disclose or suggest different types of force sensations in combination with other features of independent claim 134, independent claim 134 is allowable over the *Kelley* article. Claims 135-144 depend from independent claim 134, and are allowable for at least that reason. Applicants respectfully request allowance of these claims.

Claims 149 and 157 are Patentable Over Kelley

As discussed during the interview, independent claims 149 and 157 recite “sensation parameters including a duration parameter.” The *Kelley* article fails to disclose a sensation parameter having a duration parameter. The Examiner stated that the *Kelley* article inherently includes a duration parameter because the force feedback terminates at some instance.

The Applicants respectfully disagree. “Under the principles of inherency,” “a claim is anticipated only” if a structure in the prior art *necessarily* functions in accordance with the limitations of a process or method claim.” *In re King*, 801 F.2d 1324 (Fed. Cir. 1986). “[A] retrospective view of inherency is not a substitute for some teaching or suggestion which supports the selection and use of the various elements in the particular claimed combination.” *In re Newell*, 891 F.2d 899 (Fed. Cir. 1989). Here, the existence of a duration parameter, however, is not inherent because the *Kelley* device may have a force feedback that continues for as long as a user is interacting with a particular item. Thus, the *Kelley* article discloses a system that may output force feedback without a duration parameter.

Unlike the device disclosed in the *Kelley* article, the present invention, as recited in claims 149 and 157 includes “sensation parameters including a duration parameter.” At least

because the *Kelley* article does not disclose or suggest such duration parameters, claims 149 and 157 are allowable over the *Kelley* article. Claims 150-156 and 158-165 depend from independent claims 149 and 157, and are allowable for at least that reason. Applicants respectfully request allowance of these claims.

Allowable Subject Matter

Applicants appreciate the indication of allowable subject matter.

CONCLUSION

All of the stated grounds of objection and rejection have been properly traversed or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections, and that they be withdrawn. Applicants believe that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that further personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.


Prompt and favorable consideration of this Amendment is respectfully requested.

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